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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LAYE, JADE O

ART UNIT PAPER NUMBER

2617

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,066

Applicant(s)

JAFF ET AL.

Examiner

Jade O. Laye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/02 & 2/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 2/11/02 and 2/27/04 are in compliance with the provisions of 37 CFR 1.97. Accordingly, each has been considered by the examiner.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter of claims 6 and 15. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 6 and 15 recite "...wherein the associated event is removed from the unselected programs." The Examiner could not ascertain what Applicant meant by this limitation, nor could the Examiner find where in the Specification Applicant enabled this limitation. For the purposes of examination, the Examiner assumes Applicant meant "...wherein the associated event is removed from the *selected* programs."

Claim Objections

3. Claims 4, 5, 13, and 14 are objected to because of the following informalities:
- a. Claims 5 and 14 refer to "...the programs identified in the current program guide data to be associated with an event," which lacks antecedent basis.
 - b. Claims 4 and 13 recite "...wherein step for retrieving...". This appears to be a typo which should recite "...wherein *the* step for retrieving...".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3, 5-12, 14-26, and 28-42, and 44-47 are rejected under 35 U.S.C. 102(a) as being anticipated by Ellis et al. (US Pat. Pub. No. 2005/0028208).

As to claim 1, Ellis discloses a hand-held device, which provides users with access to television systems from remote locations. More specifically, the system of Ellis comprises a bi-directional network and a electronic programming guide ("EPG"), which is displayed on said hand-held device wherein the user is allowed to select, schedule, and send events to television systems. (Abstract ; Pars. [0010-0015, 0093, & 0094]). Accordingly, Ellis et al anticipate each and every limitation of claim 1.

Claims 10 and 40 correspond to the method claim 1. Thus, each is analyzed and rejected as previously discussed. (Note: Claim 40 is distinguished from claim 1 in that it recites a satellite communications link. However, this limitation is encompassed within the limitations of claim 1 and is also disclosed in the cited portions of Ellis used to reject claim 1.).

As to claims 2 and 3, Ellis further discloses the system may poll the user television equipment or hand-held device via the use of authorization techniques. (Par. [0007, 0070, & 0186]). Accordingly, Ellis et al anticipate each and every limitation of claims 2 and 3.

Claims 11 and 41 correspond to the method claim 2, while claim 12 corresponds to the method claim 3. Thus, each is analyzed and rejected as previously discussed.

As to claim 5, Ellis further teaches that supplemental data related to programming can be provided (i.e., associated with an event). (Pars. [0029, 0067, & 0154]). Accordingly, Ellis et al anticipate each and every limitation of claim 5.

Claim 14 corresponds to the method claim 5. Thus, it is analyzed and rejected as previously discussed.

As to claim 6, Ellis further teaches that programs can be canceled (i.e., unselected) after being selected. (Par. [0219]). Accordingly, Ellis et al anticipate each and every limitation of claim 6.

Claim 15 corresponds to the method claim 6. Thus, it is analyzed and rejected as previously discussed.

As to claim 7, Ellis further teaches a user can set preferences for a number of guide features such as recording, canceling events, and locking/unlocking events (i.e., parental controls). (Par. [0014, 0015, & 0219]). Accordingly, Ellis et al anticipate each and every limitation of claim 7.

Claims 16, 44, and 47 correspond to the method claim 7. Thus, each is analyzed and rejected as previously discussed.

As to claim 8, Ellis further teaches the system can format data (i.e., communications construct encompasses data formatting) for the hand-held device. (Par. [0149 & 0150]). In paragraph 13 of the Specification, Applicant states "In some instances, the access device uses a device service *that formats the program guide data...*". Accordingly, the Examiner broadly

interprets Ellis's communication construct to denote Applicant's "device service." Therefore, Ellis et al anticipate each and every limitation of claim 8.

Claims 17 and 42 correspond to the method claim 8. Thus, each is analyzed and rejected as previously discussed.

As to claim 9, Ellis further teaches the system utilizes an authorization technique and formats (i.e., communications construct) the retrieved EPG for use in the hand-held device. (Pars. [0007, 0070, 0149, 0150, & 0186]). Accordingly, Ellis et al anticipate each and every limitation of claim 9.

Claims 18 and 46 correspond to the method claim 9. Thus, each is analyzed and rejected as previously discussed.

As to claim 19, Ellis further discloses the set top box can be connected via a cable modem or any other communications link. (Par. [0086]). The remainder of the limitations recited in claim 19 are combinations of limitations recited in claims 1, 2, 5, and 9. In so far as the correlate, claim 19 is analyzed and rejected as discussed therein.

Claims 28, 29, 34, and 35 correspond to the method claim 19. Thus, each is analyzed and rejected as previously discussed.

Claims 20, 21, and 22 are encompassed within the limitations of claims 3, 9, and 1, respectively. Thus, each is analyzed and rejected accordingly.

As to claim 23, Ellis further teaches programs can be selected for recording via the remote terminal. (Par. [0015]). Accordingly, Ellis et al anticipate each and every limitation of claim 23.

As to claim 24, Ellis further teaches a program previously selected for recording can be subsequently canceled. (Par. [0219]). Accordingly, Ellis et al anticipate each and every limitation of claim 24.

As to claim 25, Ellis further teaches a user can change the settings of the EPG (i.e., favorite channels, parental locks, etc.). (Pars. [0015, 0116, 0123, 0124, 0159, 0161, & 0162]). Accordingly, Ellis et al anticipate each and every limitation of claim 25.

Claim 26 is encompassed within the limitation of method claim 7. Thus, it is analyzed and rejected as discussed therein.

As to claim 30, Ellis further teaches the hand-held device can be a PDA or other hand-held device. (Pars. [0092]). Accordingly, Ellis et al anticipate each and every limitation of claim 30.

Claim 36 corresponds to the method claim 30. Thus, it is analyzed and rejected as previously discussed.

The limitations of claim 31 are encompassed within the limitations of claim 9. Thus, it is analyzed and rejected as discussed therein.

Claim 37 corresponds to the method claim 31. Thus, it is analyzed and rejected as previously discussed.

Claims 32 and 33 are encompassed within the limitations of claim 3. Thus, each is analyzed and rejected as discussed therein.

Claims 38 and 39 correspond to the method claims 32 and 33, respectively. Thus, each is analyzed and rejected as previously discussed.

Claim 45 corresponds to the method claim 24. Thus, it is anticipated and rejected as discussed therein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 4, 13, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Herrington et al. (WO 00/78050).

Claim 4 recites the method of claim 1, wherein the step for retrieving guide data comprises steps for: displaying the guide on the access device; and displaying previously scheduled events on access device. As discussed above, Ellis et al anticipate each and every limitation of claim 1, and further teach the programming guide is displayed on the access device (i.e., remote terminal). (as discussed under cited portions used to reject claim 1). But, Ellis fails to specifically disclose the remaining limitation of claim 4. However, within the same field of endeavor, Herrington et al disclose a similar system in which the programming guide displays past events. (Pg. 35, Ln. 15-33 thru Pg. 37, Ln. 1-27). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicants invention to combine the systems of Ellis and Herrington in order to provide a remote access system capable of displaying past events, thereby supplying the user with a more exhaustive program listing.

Claims 13 and 43 correspond to the method claim 4. Thus, each is analyzed and rejected as previously discussed.

6. Claims 27 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al in view of Artigalas et al. (US Pat Pub. No. 2001/0014206).

Claim 27 recites the method of claim 19, wherein the step for selecting an event at the remotely located access device further comprises a step for deleting previously recorded programming content. As discussed above, Ellis et al anticipate each and every limitation of claim 19, but fail to specifically recite the limitations of claim 27. However, within the same

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field of endeavor, Artigas et al disclose a similar system in which the user is allowed to delete previously recorded programming. (Abstract ; Par. [0006 & 0049]). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Ellis and Artigas in order to provide a system, which allows a consumer to build a personal video and/or audio library.

The limitations of claim 48 are encompassed within the limitations of claim 27. Thus, it is analyzed and rejected as previously discussed.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Schultz et al (US Pat. No. 5,679,943) disclose a hand held terminal capable of multiple tasks.
- b. Susskind (US Pat. Pub. No. 2001/0046366) discloses a system for controlling remote devices.
- c. Ekel et al (US Pat. Pub. No. 2002/0002707) disclose a system to display remote content.
- d. Iwai (US Pat. Pub. No. 2002/0021766) discloses a system wherein a user can make program reservations on a remote.
- e. Terakado et al (US Pat. No. 6,246,441) disclose a system and method, which utilizes a remote terminal to control a television display system and EPG.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials JL
June 3, 2005.


NGOE-YEN VU
PRIMARY EXAMINER